

II. AMENDMENTS TO CLAIMS

26. (New) A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:
- dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;
- creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;
- creating an advertisement;
- distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement;
- collecting said playing pieces comprising one of said distinct parts;
- sequencing said playing pieces into a correctly ordered sequence of words in said literary work;
- sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and
- winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.

27. (New) The method of claim 26 wherein said advertisement is a corporate name.

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28. (New) The method of claim 26 wherein said advertisement is an advertising campaign.

Table 1 – Comparison of elements of new claim 26 with Peppel:

Claim 26 (New)	Peppel
A. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:	<p>Peppel's disclosure does not relate to promoting literacy and reading. Likewise, it does not show a "competition" related to a "literary work" in association with an "advertisement". It is to be noted that the literary work must be at least 100 words and constitute an original work of authorship.</p> <p>Instead, Peppel teaches an electronic trading card (ETC) which is a metaphor for a standard trading card. Peppel mentions collecting the ETCs; linking code segments, games, puzzles and utilities; creating of card albums; linking to motion pictures including narratives, animation, and documentaries; receiving a reward; and offerings for promotional purposes. However, these teachings do not relate to promoting literacy and reading or competition related to a "literary work".</p>
B. dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;	<p>There is no teaching of dividing a "literary work" and no teaching of a "correctly ordered sequence of words" or a plurality of distinct parts with no readily identifiable means of determining the correct sequence.</p>
C. creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;	<p>There is no teaching of creating playing pieces where each playing piece comprises one of said "distinct parts".</p>
D. creating an advertisement	
E. distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement	<p>There is no teaching of distributing the playing pieces, which has a "distinct part" and in association with said advertisement.</p>

Claim 26 (New)	Peppel
F. collecting said playing pieces comprising one of said distinct parts;	There is no teaching of collecting “said playing pieces comprising one of said distinct parts”.
G. sequencing said playing pieces into a correctly ordered sequence of words in said literary work;	There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”.
H. sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and	There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”.
I. winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.	There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”.

McGuire is a secondary reference and discloses primarily a puzzle of the movies game.

Table 2 – Comparison of elements of new claim 26 with McGuire:

Claim 26 (New)	McGuire
A. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:	<p>McGuire's disclosure does not show promoting literacy and reading related to a "literary work" in association with an advertisement.</p> <p>McGuire discloses a puzzle game employing a set of cards each having a scene, an object, or descriptive matter. The solution is to arrange the cards in a sequence that constitutes the logical order of the development of a story or picture play interspersed with appropriate written matter such as subtitles, etc., which are necessary to make clear the action portrayed.</p> <p>The McGuire cards include a printed sheet suggesting the theme of the story or plot in the picture play on the card.</p> <p>In one example, McGuire shows a picture of a letter being read but the letter is not a "literary work" since it is less than 100 words.</p>
B. dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;	There is no teaching of dividing the "literary work" and no teaching of a "correctly ordered sequence of words" or a plurality of distinct parts with no readily identifiable means of determining the correct sequence.
C. creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;	There is no teaching of creating playing pieces where "each playing piece comprises one of said distinct parts".
D. creating an advertisement	There is no teaching of creating an advertisement.

Claim 26 (New)	McGuire
E. distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement	There is no teaching of distributing the playing pieces, which has a “distinct part” and in association with said advertisement.
F. collecting said playing pieces comprising one of said distinct parts;	There is no teaching of collecting “said playing pieces comprising one of said distinct parts”.
G. sequencing said playing pieces into a correctly ordered sequence of words in said literary work;	There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”.
H. sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and	There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”.
I. winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.	There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”.

Schoolfield is another secondary reference and discloses primarily a game played with cards for entertainment and amusement of the players and educational value by familiarizing the players with scenes and dialogues from literature.

Table 3 – Comparison of elements of new claim 26 with Schoolfield:

Claim 26 (New)	Schoolfield
A. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:	Schoolfield's disclosure shows promoting literacy but is not related to a "literary work" in association with an advertisement. Schoolfield shows cards having a few words (less than 100) that are a preview of the rest of literature.
B. dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;	There is no teaching of dividing the "literary work" and no teaching of a "correctly ordered sequence of words" or a plurality of distinct parts with no readily identifiable means of determining the correct sequence.
C. creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;	There is no teaching of creating playing pieces where each playing piece comprises one of said distinct parts.
D. creating an advertisement	There is no teaching of creating an advertisement.
E. distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement	There is no teaching of distributing the playing pieces, which has a "distinct part" and in association with said advertisement.
F. collecting said playing pieces comprising one of said distinct parts;	There is no teaching of collecting "said playing pieces comprising one of said distinct parts".
G. sequencing said playing pieces into a correctly ordered sequence of words in said literary work;	There is no teaching of "sequencing said playing pieces into a correctly ordered sequence of words in said literary work".

Claim 26 (New)	Schoolfield
H. sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and	There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”.
I. winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.	There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”.

For purposes of simplifying the issues, Applicant has cancelled all the claims and inserted new independent claim 26. Also, new dependent claims 27 and 28 have been added and would be allowable for the same reason claim 26 is allowable.

As can be seen from the above claim charts, most elements of claim 26 are not found in the three references and the claimed invention is clearly patentable thereover. It is believed the Examiner has used Applicant's own disclosure as a blueprint to try and mosaic together components from three different references to attempt to show the claimed invention. This is a classic case of hindsight knowledge. If one of ordinary skill in the art had all three references prior to Applicant's invention, they would never have created the claimed invention. This is in effect “using that which the inventor has taught against its teacher”. (W.L. Gore v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983)).

The law requires that, in order to prevent the use of hindsight based on the invention to defeat patentability of the invention, there must be shown a motivation to combine the references that create the case of obviousness, in other words, there must be

shown reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). The central question is whether there is a reason to combine the references, a question of fact drawing on the Graham factors.

The factual inquiry whether to combine references must be thorough and searching. *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding”) (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *In re Dembicza*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”); *In re Fine*, 5 USPQ2d 1596, 1600

(Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp. 221 USPQ 929, 933 (Fed. Cir. 1984).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); In re Rouffet, 149 f.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”).

Here there is no showing in any of the references, individually or in any suggested combination, teaching Applicant’s claimed invention.

It is believed the three claims are clearly patentable in their present form.